



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,735	12/22/2000	Robert L. Jones	P0539	4620

23735 7590 12/05/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

FRECH, KARL D.

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/747,735	JONES, ROBERT L.	
	Examiner	Art Unit	
	Karl D Frech	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,12-16,18,22,23 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 2,9-11,17,19-21,24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/22/03 . 6) ☐ Other: _____

Art Unit: 2876

1. The amendment filed August 22, 2003 has been entered. Claims 1,2,9-13 have been amended and claims 14-27 have been added.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-8,14,16,18,22,25,26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai et al 6,160,526. Hirai discloses, as seen in figure 37 for example, a substantially non-rigid core layer 1C, an antenna 30 affixed to the core layer, an integrated chip 2 connected to the antenna 30, a substantially non-rigid bottom sheet 7B bonded to the core layer 1C and sandwiching the antenna 30 and chip 2 between the core layer 1C and the bottom sheet 7B. There is disclosed a polymer layer 70 attached to the second side of the core layer 1C. **** Hirai does not specifically disclose the adhesive layers as currently claimed. However, adhesive layers used between structural layers of circuit cards are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use well known adhesive layers to bond the structural layers of Hirai in order to securely attach the pieces of the Hirai circuit card into one unit. Hirai discloses in another embodiment a second polymer layer 71 (see fig 31) attached to the bottom sheet by an adhesive layer. It would have been obvious to adhere a second polymer to the "other" side of the card of Hirai in order to protect the "other" side from the external elements. Hirai does not disclose the images or printing of images on outer surfaces of the card. As seen in the previous office

Art Unit: 2876

action, printing images on circuit cards is old and well known. For the same reasons as previously set forth, it would have been obvious to a person of ordinary skill in the art to print images on the outer surfaces of the card of Hirai. This would, for example, allow for visual recognition of the card.

4. Claims 12,13,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai et al 6,160,526 as applied to claims 1, 3-8,14,16,18,22,25,26,27 above, and further in view of JP 11259620 A. Hirai does not disclose the substance of the layers. JP discloses card layers which can be of the polyester group or polyolefin (among others). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the layer substances of JP 11259620 A for the layers of Hirai in order to effectively protect the inner layers, antenna and circuit of Hirai from the external elements.

5. Claims 2,9-11,17,19,20,21,24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art, in conjunction with all the other claimed limitations, re claims 2,9-11,17,19, the release or anti-binding agent; re claims 20,21,24, the substantially rigid layer.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2876

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (703) 305 3491. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305 3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.



Karl D Frech
Primary Examiner
Art Unit 2876